



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

✓
JW

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,559	12/17/2001	Klaus Kramer	52049	6211
26474	7590	07/29/2005	EXAMINER	
NOVAK DRUCE DELUCA & QUIGG, LLP			WANG, SHENGJUN	
1300 EYE STREET NW				
SUITE 400 EAST			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20005			1617	

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/015,559	KRAMER ET AL.	
	Examiner Shengjun Wang	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 12 May 2005.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 3-9 and 11 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 3-9, 11 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

Receipt of applicants' amendments and remarks submitted May 12, 2005 is acknowledged.

Claim Rejections 35 U.S.C. 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eziri et al. (US 4,728,650).

Eziri et al. teaches a 5% ethanol solution of the chroman of formula Ia herein. See, particularly, example 27 in columns 26-27. Note ethanol is deemed to be a cosmetically acceptable carrier. Also, ethanol is a well-known bactericidal agent. Further, it is well settled that the "intended use," such as those recited herein, of a product or composition will not further limit claims drawn to a product or composition. See, e.g., In re Hack 114 USPQ 161.

Claim Rejections 35 U.S.C. 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1617

4. Claims 3-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deckner et al. (EP 0 238 302, IDS), in view of Wechter et al. (US 6,048,891, 6,555,575).
5. Deckner et al. teaches a cosmetic, or topical composition comprising 6-hydroxy-2,5,7,8-tetramethyl-chroman-2-carboxylic acid in the amount of 0.01 to 50% as a free radical inhibitor and method of using the same for inhibiting generation of free radical in the skin. See, particularly, pages 2-4, and the claims.
6. Deckner et al. do not teach expressly the employment of 6-hydroxy-2,5,7,8-tetramethyl-chroman-2-ethylenecarboxylic acid.
7. However, Wechter et al. teaches that carboxylic derivatives of tocopherols are similarly useful as therapeutical agents, particularly, as antioxidants, or free radical inhibitors. See, particularly, columns 6-11, 35-37 in '891. The length of the linker between the carboxyl moiety and chroman may be varied from a bond to five methylenes. See formula I in column 6, wherein m is defined as 0-5. Wechter et al. expressly teaches that 6-hydroxy-2,5,7,8-tetramethyl-chroman-2-ethylenecarboxylic acid is useful as antioxidant agent. See, particularly, the claims in '575.
8. Therefore, it would have been *prima facie* obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to use 6-hydroxy-2,5,7,8-tetramethyl-chroman-2-ethylenecarboxylic acid in Deckner's cosmetic composition and use the same for protecting skin.
9. A person of ordinary skill in the art would have been motivated to use 6-hydroxy-2,5,7,8-tetramethyl-chroman-2-ethylenecarboxylic acid in Deckner's cosmetic composition and use the same for protecting skin because carboxylic derivatives of tocopherols in general, and 6-

Art Unit: 1617

hydroxy-2,5,7,8-tetramethyl-chroman-2-ethylenecarboxylic acid in particular, are known to be similarly useful as antioxidants, or free radical inhibitors.

Response to the Arguments

Applicants' amendments and remarks submitted May 12, 2005 have been fully considered, but are deemed unpersuasive with respect to they rejections set forth above.

Regarding the rejections under 35 U.S.C. 102(b), note ethanol is a bactericidal agent. Thus, the ethanol solution disclosed by Eziri et al. would read on the claimed composition.

As to the rejections under 35 U.S.C. 103 over Deckner et al. in view of Wechter, applicants argue that Wechter discloses that tocopherol derivatives may exhibit different biological properties from one another despite their structural similarities, therefore, applicants concluded that Wechter "cannot reasonably be considered to teach or suggest to a person of ordinary skill in the art that applicants compound (Ia) could be useful as antioxidant or a free radical inhibitor." The arguments are not persuasive. Applicants make general statements that tocopherol derivatives *may* differ in their biological activity, without analysis of the specific situation herein and without addressing the particular issues raised in the rejections. Specifically, as admitted by applicants, it has been recognized in the art that tocopherol derivatives are antioxidants. Possible differences among the derivatives do not necessarily means they are distinct each from the others. Applicants completely ignore the teaching by Wechter that the difference of the linker between the carboxylic group and chroman does not affect the biological activity significantly (see the rejections above). Further, applicants ignores the fact that Wechter et al. expressly teaches that 6-hydroxy-2,5,7,8-tetramethyl-chroman-2-ethylenecarboxylic acid is

useful as antioxidant agent. Wechter fairly suggests that 6-hydroxy-2,5,7,8-tetramethyl-chroman-2-ethylenecarboxylic acid would be similarly useful as antioxidant and free radical inhibitor.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 1617

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SHENGJUN WANG
PRIMARY EXAMINER
Shengjun Wang
Primary Examiner
Art Unit 1617